

REMARKS

No claims have been amended, canceled or added in this response. Applicant respectfully traverses the rejections, for the reasons set forth in Applicant's previous response, filed on 12/19/2005.

Claims 1-3, 5, 6, 8, 9, 16-18, 20, 21, 23, 25-27, 29, 30, 32 and 33 stand rejected under 35 U.S.C. § 103(a) based on U.S. Patent no. 6,687,242 of Enzmann et al. ("Enzmann") in view of U.S. Patent application publication no. 2002/0019225 of Miyashita ("Miyashita"). Claims 4, 19 and 28 stand rejected under 35 U.S.C. § 103(a) based on Enzmann in view of Miyashita and further in view of Fleming. Claims 7, 22 and 31 stand rejected under 35 U.S.C. § 103(a) based on Enzmann in view of Miyashita and further in view of Ho et al. Claims 9, 24 and 33 stand rejected under 35 U.S.C. § 103(a) based on Enzmann in view of Miyashita and further in view of Armanto.

The Examiner maintains the rejections from the previous Office Action. However, it appears that the Examiner has misread Applicant's last response.

The Examiner provides only two points in response to Applicant's arguments, both of which are stated on page 2 of the Final Office Action. First, the Examiner states:

"The applicant argues that claim 1 recites the feature of obtaining data associated with the telephone number via the wireless network in response to an incoming voice call. However, the claim does not recite that the call is an incoming call." (Final Office Action, p. 2)(emphasis original)

However, Applicant has not argued that the call must be an incoming call. To the contrary, Applicant made clear in the last response that the voice call in claim 1 could be *either* an incoming call *or* an outgoing call. The language in the independent claims is not restricted to either type of call. The only mention of "incoming call" in Applicant's last response was in the

context of an *example*, given *prior* to Applicant's discussion of the claims. Furthermore, that example also specifically noted the call could be an outgoing call. This, of course, is not Applicant's main point of argument, but it is responsive to the clearly inaccurate statement by the Examiner.

Second, the Examiner states:

Regarding claim 1, the applicant argues on page 11 that Miyashita does not disclose that data associated with the telephone number is obtained and stored in the contact database automatically. Examiner disagrees with this argument. The examiner did not rely upon Miyashita for the teaching of obtaining data associated with the telephone number. The examiner relied upon Miyashita only for the teaching of storing **the data in the contact database** (page 2, paragraphs 0020, 0021) after Enzman teaches that such data is retrieved according to the telephone number. Thus, the examiner maintains the rejection of the claims in view of Enzmann and Miyashita. (Final Office Action, p. 2)(emphasis original)

The Examiner has missed the point. Applicant clearly argued that *neither* Enzmann *nor* Miyashita discloses or suggests *automatically* obtaining and storing data associated with the telephone number in a contact database in a mobile communication device *in response to* a call event representing a voice call involving the mobile communication device, particularly in combination with the other recited steps of claim 1. See Applicant's last response, first paragraph on page 12.

Enzmann clearly requires a *manual user action* in response a call event in order to obtain additional information about the calling party. See abstract; col. 5, lines 3-5; and Fig. 3a step 311. Therefore, Enzmann fails to disclose or suggest *automatically* obtaining and storing data associated with the telephone number in a contact database in a mobile communication device in response to a call event representing a voice call involving the mobile communication device.

Miyashita discloses that the directory data is downloaded "*in response to an operation by a user of the mobile device*," i.e., not automatically. See, paragraph [0021] (emphasis added). Therefore, Miyashita also fails to disclose or suggest *automatically* obtaining and storing data associated with the telephone number in a contact database in a mobile communication device in response to a call event representing a voice call involving the mobile communication device.

Therefore, no *combination* of Enzmann nor Miyashita discloses or suggests *all of the limitations* of Applicant's claims, and in particular, that data associated with the telephone number is obtained and stored in the contact database in a mobile communication device *automatically* in response to a call event representing a voice call involving the mobile communication device, particularly in combination with the other recited steps of claim 1. As such, claim 1 and all claims which depend on it are patentable over the cited art.

Furthermore, the Examiner did not respond to Applicant's argument that there is *no suggestion or motivation* in the prior art to combine the teachings of Miyashita with those of Enzmann. Therefore, it must be assumed that the Examiner admits the correctness of Applicant's argument. The motivation alleged by the Examiner is: "... in order to retrieve contact information from the storage whenever a person needs to contact without any inconvenience." Final Office Action, p. 4. Applicant finds no support in the prior art for that bare bones statement of motivation. The Examiner clearly is relying on hindsight that is based *only on Applicant's disclosure* and is, therefore, *improper*. The suggestion or motivation to combine references may not be found using hindsight gleaned from the applicant's specification. *In re Rouffet*, 149 F.3d 1350, 1358 (Fed. Cir. 1998). While hindsight may be unavoidable to some extent in evaluating obviousness, it is never permissible *when it is gained from an applicant's disclosure. Id.*

For this additional reason, therefore, claim 1 is patentable over the cited art.

Independent claims 16 and 25 contain limitations similar to those discussed above and are, therefore, also patentable over the cited art for similar reasons.

Dependent Claims

In view of the above remarks, a specific discussion of the dependent claims is considered to be unnecessary. Therefore, Applicants' silence regarding any dependent claim is not to be interpreted as agreement with, or acquiescence to, the rejection of such claim or as waiving any argument regarding that claim.

Conclusion


For the foregoing reasons, the present application is believed to be in condition for allowance, and such action is earnestly requested.

If any additional fee is required, please charge Deposit Account No. 02-2666.

Respectfully submitted,

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